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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,126	06/18/2007	Marcus Meichsner	FI-82PCT	4053
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NEW YORK, NY 10017				
EXAMINER				
WALTERS JR, ROBERT S				
ART UNIT		PAPER NUMBER		
1792				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,126

Applicant(s)

MEICHSNER ET AL.

Examiner

ROBERT S. WALTERS JR

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 8/18/2006, 8/18/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

Claims 1-13 are pending and presented for examination.

Claim Objections

Claims 5, 7 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are of improper dependent form because they depend from themselves.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-13 provide for the use of a UV-curable baking enamel, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for

example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. The term "low molecular mass" in claims 8 and 9 is a relative term which renders the claim indefinite. The term "low molecular mass" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

3. Claim 13 recites the limitation "after the electrical wire has been coated with baking enamel". There is insufficient antecedent basis for this process step limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton et al. (WO00/77066).

I. Regarding claims 1-5, 7-9 and 12, Hatton teaches the use of a UV-curable enamel containing an oxirane-based binder and a cationic photopolymerization crosslinking catalyst (see Example 15, page 17), cyracure uvi 6990 (which is a mixed arylsulfonium hexafluorophosphate salt of the form of claim 5). Hatton further teaches the use of reactive diluents such as low molecular weight epoxides (page 8, lines 38-40) in the composition. Hatton further teaches that the oxirane binder can be prepared from a cycloaliphatic oxirane as claimed (see formula at the bottom of page 2) and polyethylene glycol (page 5, lines 19-22). Finally, Hatton teaches that further additives may be added as needed (page 9, lines 2-5).

Hatton fails to explicitly teach the weight % of each of the components. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that the percentage of each component would affect the quality of a coating prepared from the

composition, such as hardness, curing speed, as well as the ease of coating the composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed ranges through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

II. Regarding claim 6, Hatton teaches all the limitations of claim 1, but fails to explicitly teach the use of methyl-3,4-epoxycyclohexanecarboxylate. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that this particular epoxide could be substituted for those taught by Hatton with a reasonable expectation of success (as it would be expected to react with the polyethylene glycol identically to produce an oxirane-based binder), and the predictable result of providing an oxirane-based binder for a UV-curable coating composition.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton in view of Yamamura et al. (U.S. Pat. No. 6127085).

Regarding claims 10 and 11, Hatton teaches all the limitations of claim 1, but fails to teach the use of polyester polyols having the claimed molecular weights as chain transfer agents. However, Yamamura teaches a similar photo-curable epoxy resin composition (abstract), which incorporates polyester polyols (column 9, lines 7-9) having a molecular weight of 160-1000

(column 9, lines 31-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hatton by including the polyester polyols, as disclosed by Yamamura. One would have been motivated to make this modification as Yamamura teaches that the incorporation of these compounds into curable epoxy resin compositions provides shape stability and stability in properties, as well a part of the photo-curability of the resin (column 8, lines 56-61).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton in view of Kwiecinski (U.S. Pat. No. 4362263).

Regarding claim 13, Hatton teaches all the limitations of claim 1 including coating the composition (see Example 15, page 17), and its use as an insulator (page 9, lines 18-21). Hatton further teaches curing the coating by UV radiation (see Example 15, page 17). Hatton fails to particularly teach an electrical wire being coated with the composition. However, Kwiecinski teaches a similar UV-curable epoxy composition that is used for coating electrical wire (abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hatton's method by coating and curing the epoxy composition on an electrical wire, as disclosed by Kwiecinski. One would have been motivated to make this modification as Hatton actually teaches that the composition can be used for insulation and potting (page 9, lines 18-21).

Conclusion

Claims 1-13 are pending.

Claims 1-13 are rejected.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT S. WALTERS JR whose telephone number is (571)270-5351. The examiner can normally be reached on Monday-Friday, 8:00am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Barr/
Supervisory Patent Examiner, Art Unit
1792

/ROBERT S. WALTERS JR/
June 20, 2009
Examiner, Art Unit 1792

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